



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

*nh*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,734	06/12/2001	Ronald Llewellyn Burges	CNF-001	4876

7590 02/02/2007  
THE H. T. THAN LAW GROUP  
1010 WISCONSIN AVE., NW  
SUITE 560  
WASHINGTON, DC 20007

EXAMINER
----------

SMITHERS, MATTHEW

ART UNIT	PAPER NUMBER
----------	--------------

2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/879,734

Applicant(s)

BURGES ET AL.

Examiner

Matthew B. Smithers

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-13 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-13 and 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 19 recites the use of an electronic safety deposit system using the method of claim 1. Claim 19 does not further limit any of the method steps of claim 1 and as such is not a proper dependent claim.

Further, claims 9 and 19 are objected to under 37 CFR 1.75(b), where more than one claim may be presented provided they differ substantially from each other and are not unduly multiplied. In the instant application, the scope of claim 19 is substantial equivalent to the scope of claim 9.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8-11, 13, and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 20040024717 granted to Wells et al.

Regarding claim 1, Wells meets the claimed limitations as follows:

"A method of controlling access to electronic information comprising the steps of:

providing at least one user apparatus;

a remote server; and

a communications link between the at least one user apparatus and the remote server;

allocating disk storage space on the remote server unique to the at least one user apparatus;

allowing at least one user access to the storage space via username and password login to the server and via secure encryption of data sent to or from the user apparatus from or to the server;" see paragraphs [0019] and [0030]-[0032] and

allowing at least one further user access to the data storage space and wherein the further users access to the data storage space can be managed by the at least one user with regard to times and dates when the at least one further user can write to and/or read from the data storage space." see paragraphs [0020], [0026] and Figures 3 and 8.

Regarding claim 8, Wells meets the claimed limitations as follows:

"A method of controlling access to electronic information as claimed claim 1, wherein the communications link comprises the Internet.

Regarding claim 9, Wells meets the claimed limitations as follows:

"An electronic safety deposit system or tender box system comprising:

at least one user apparatus;

a remote server;

a communications link between the at least one user apparatus and the remote server;

disk storage space allocated on the remote server unique to the at least one user apparatus;

means for allowing at least one user access to the storage space via username and password login and via secure encryption of data sent to or from the user apparatus from or to the server; " see paragraphs [0019] and [0030]-[0032]

means for allowing at least one further user access to the data storage space; and means for managing the further users access to the data storage space by the at least one user with regard to times and dates when the at least one further user can write to and/or read from the data storage space." see paragraphs [0020], [0026] and Figures 3 and 8.

Regarding claim 10, Wells meets the claimed limitations as follows:

"A method of providing an account-based Internet/Intranet service which allows an at least one account holder to:

create at least one secure electronic deposit box on a centralised server in which box or boxes store documentation in a secure environment;

manage timeframes for invited participants to access said documentation and/or for the invited participants to upload to the centralised server further documentation,

wherein the method utilizes a method of controlling access to electronic information as claimed in claim 1." see paragraphs [0019]-[0020], [0025]-[0026], [0037]-[0038] and Figures 2, 3 and 8.

Regarding claim 11, Wells meets the claimed limitations as follows:

"A method as claimed in claim 10, wherein the method further allows the at least one account holder to track activity relating to each said at least one electronic deposit box." see paragraphs [0025] and [0041].

Regarding claim 13, Wells meets the claimed limitations as follows:

"A programmed computer or server adapted to implement the method of claim 1." see paragraph [0019].

Regarding claim 19, Wells meets the claimed limitations as follows:

"Use of an electronic safety deposit system or tender box system in a method of controlling access to electronic information as claimed in claim 1." see paragraphs [0019]-[0020], [0026], [0030]-[0032] and Figures 3 and 8.

Regarding claim 20, Wells meets the claimed limitations as follows:

"A programmed computer or server adapted to implement the method of claim 10." see paragraph [0019].

Regarding claim 21, Wells meets the claimed limitations as follows:

"A programmed computer or server adapted to implement the method of claim 11." see paragraph [0019].

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 7, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent application 20040024714 granted to Wells et al and further in view of US patent 6,892,300 granted to Carroll et al.

Regarding claims 2, 3, 4, and 5, Wells discloses everything claimed as applied above (see claim 1), however Wells fails to teach users using digital certificates during secure transactions between the user and the electronic deposit box. Carroll teaches a secure method for conducting electronic commerce transactions with vault-based applications (safety deposit box) where users are required to present their digital certificates to gain access to the vault (see column 4, lines 44-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll's secure electronic commerce with vault agents with Wells' electronic safe deposit box for the purpose of verifying specific users of the system. One of ordinary skill in the art would have been motivated to combine the two to gain the advantage of certifying the specific user conducting certain activities within the system (see Carroll; column 2, lines 26-33).

Regarding claim 7, Wells discloses everything claimed as applied above (see claim 1), however Wells fails to teach any users using digital certificates during secure transactions between the user and the electronic deposit box. Carroll teaches a secure

Art Unit: 2137

method for conducting electronic commerce transactions with vault-based applications (safety deposit box) where users are required to present their digital certificates to gain access to the vault (see column 4, lines 44-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll's secure electronic commerce with vault agents with Wells' electronic safe deposit box for the purpose of verifying specific users of the system. One of ordinary skill in the art would have been motivated to combine the two to gain the advantage of certifying the specific user conducting certain activities within the system (see Carroll; column 2, lines 26-33).

Regarding claims 12 and 18, Wells discloses everything claimed as applied above (see claim 9), however Wells fails to teach using digital certificates during secure transactions between the user and the electronic deposit box. Carroll teaches a secure method for conducting electronic commerce transactions with vault-based applications (safety deposit box) where users are required to present their digital certificates to gain access to the vault (see column 4, lines 44-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll's secure electronic commerce with vault agents with Wells' electronic safe deposit box for the purpose of verifying specific users of the system. One of ordinary skill in the art would have been motivated to combine the two to gain the advantage of certifying the specific user conducting certain activities within the system (see Carroll; column 2, lines 26-33).

Regarding claim 17, Wells as modified discloses everything claimed as applied above (see claim 2), in addition Wells teaches encrypting transactions using SSL technology (see paragraphs [0029 and [0032]).



### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Rowe (US 20020029339) discloses a method for securely storing data related to commercial transactions.

B. Curtis et al, "Securing the Global, Remote, Mobile User", discloses an electronic commerce system that controls authorized access to stored information.


C. Denning, "Secure Personal Computing in an Insecure Computing Network", discloses a system for securely storing data at a central facility or securely transmitting data to other networked users.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B. Smithers whose telephone number is (571) 272-3876. The examiner can normally be reached on Monday-Friday (8:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Matthew B Smithers  
Primary Examiner  
Art Unit 2137